

Application No.: 10/781,197  
Response to OA of 02/09/06

### Remarks

In the present response, four claims (1, 8, 10, and 16) are amended; and ten claims (53-62) are newly added. Claims 1-21 and 53-62 are presented for examination.

Claim 22-52 are canceled to comply with a previous restriction requirement. Applicants reserve the right to file continuing applications directed to restricted subject matter.

#### I. New Claims

New claims 53-62 are directed to documents with memory classified in class 235, subclass 487 and hence are within the previously elected subject matter (see Office Action Restriction dated 11/16/2005). Further, these claims recite numerous recitations that are not taught or suggested in the art of record.

#### II. Claim Rejections: 35 USC § 112

Claim 8 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Office Action states insufficient antecedent basis exists for "the security module" in line 1. This rejection is moot since claim 8 is amended.

#### III. Claim Rejections – 35 USC § 102

Claims 1 – 5 and 7 – 8 are rejected under 35 U.S.C. §102 as being anticipated by USPN 2005/0010525 (Ross). A rejection under 102 requires that a single prior art reference discloses each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Since Ross neither teaches nor suggests each element of the rejected claims, these claims are allowable over Ross.

As one example, independent claim 1 recites a memory that stores machine-readable information. The machine-readable information includes data of plural transactions in which the secure document was previously used. Ross teaches that "each tag includes details of the value of the banknote in which it is embedded" ([0105]). Nowhere does Ross teach or even suggest that a memory stores plural transactions in which the banknote was previously used.

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For at least these reasons, independent claim 1 and its dependent claims are allowable over Ross.

#### **IV. Claim Rejections – 35 USC § 103(a)**

Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ross in view of USPN 2005/0123888 (Lee). Lee fails to cure the deficiencies of Ross. Thus, for at least the reasons given above in connection with independent claim 1, dependent claim 6 is allowable over Ross in view of Lee.

#### **V. Claim Rejections – 35 USC § 103(a)**

Claims 10-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ross. Applicants respectfully traverse.

Independent claim 10 recites numerous recitations that are not taught or suggested in Ross. For example, claim 10 recites a memory storing authentication information. This authentication information indicates whether a radio frequency reader device is authorized to communicate with the currency so data can be read from and written to the memory. Ross states that the substrate “includes security features (such as fluorescent features, watermarks, and such like) to aid validation of the banknote” ([0097]). Ross, however, never suggests that the substrate stores authentication information so data can be read from and written to the banknote. For instance, Ross never suggests writing data to the banknote upon authorization.

For at least these reasons, independent claim 10 and its dependent claims are allowable over Ross.

#### **VI. Allowable Subject Matter**

Applicants thank the Examiner for allowing claims 19-21 and indicating allowance of dependent claims 9, 17, and 18.

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### CONCLUSION

In view of the above, Applicants believe all claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. 832-236-5529. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,



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#### CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper or papers, as described herein, is being transmitted to the United States Patent and Trademark Office facsimile number 571-273-8300 on this 1st day of April 2006. May 2006

By

  
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